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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,547	06/29/2001	Jonathan Sharp	042933/308761	4444
22907	7590	05/09/2007		
BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER LESNIEWSKI, VICTOR D	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 05/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/893,547

Applicant(s)

SHARP ET AL.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413).
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 3/5/2007 has been placed of record in the file.
2. Claims 15, 18, 21, 22, 23, and 26 have been amended.
3. Claims 33 and 34 have been added.
4. Claims 15-34 are now pending.
5. The applicant's arguments with respect to claims 15-34 have been considered but are moot in view of the following new grounds of rejection.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 3/5/2007 has been entered.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claims 33 and 34 recite the limitation "said monitoring" in line 12 of each claim. There is insufficient antecedent basis for this limitation in the claims. Nowhere in claims 33 and 34 is there previous mention of a monitoring downloading of the adaptation data, making the scope of the claims unclear.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 15-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng (U.S. Patent Number 6,816,944) in view of Srinivasan (U.S. Patent Number 6,460,076).

12. Peng disclosed a system for providing personalized application and data management to mobile devices. In an analogous art, Srinivasan disclosed a system for downloading data files over a data network such that customers are billed based on successful acquisition of the data files.

13. Concerning claims 15, 18, 21, 22, 23, 26, 33, and 34, Peng did not explicitly state computing remuneration data by computing the payment to be made to a content provider on the basis of the level of successful downloads from the server. Peng does use a transaction manager in order to track the progress and status of each transaction. Peng also bills the user for certain transactions, but he is not explicit about how payment to be made is computed. However, Srinivasan teaches billing customers based on the successful acquisition of data files by the

customers. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Peng by adding the ability to compute the payment to be made to a content provider on the basis of the level of successful downloads from the server as provided by Srinivasan. Here the combination satisfies the need for an automated billing process for charging customers who download information. See Srinivasan, column 1, line 64 through column 2, line 3. This rationale also applies to those dependent claims utilizing the same combination. The following line citations refer to Peng unless otherwise noted.

14. Thereby, the combination of Peng and Srinivasan discloses:

- <Claims 15, 18, and 22>

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising: providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48); providing adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26); downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26); monitoring downloading of said adaptation data by said portable radio communication device from said memory of said server to provide output data (column 7, lines 38-44); applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the output data of said monitoring downloading of said

adaptation data (column 7, lines 38-44); and computing remuneration data related to the electronic content and the adaptation data based on the generated data, the method including monitoring the volume of downloads that the server is performing and computing the payment to be made to a content provider on the basis of the level of successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36)..

- <Claims 16 and 19>

A method according to claim 15, wherein: a content provider provides said electronic content for storage on the memory of said portable radio communication device (column 8, lines 8-18 and 31-48); the content provider provides said adaptation data for storing on the memory of said server (column 15, lines 3-15); a content enabler allows access to said adaptation data for downloading from said memory of said server to said portable radio communication device (column 15, lines 13-26); and the content enabler provides for monitoring downloading of said adaptation data by said portable radio communication device from the server, generating data based on monitoring downloading of said content, and computing the remuneration data based on the generated data, the content enabler determining payment data for said content provider based on said remuneration data (column 7, lines 38-46).

- <Claims 17 and 20>

A method according to claim 15, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- <Claim 21>

A portable radio communication device operable in a radio communication network including a server, the portable radio communication device being capable of downloading adaptation data from the server, the portable radio communication device having a transceiver, a memory and a controller (column 5, lines 1-16 and column 7, lines 12-18), wherein: the memory stores electronic content (column 8, lines 8-18 and 31-48); the controller is operable to control the transceiver to transmit a request for adaptation data from the server, the request comprising an identifier of the electronic content stored on the device and security data, the identifier and the security data enabling the server to download the adaptation data to the portable radio communication device, the transceiver receives said adaptation data from the server, and the controller modifies the electronic content stored on the memory by applying to the electronic content the received adaptation data to provide adapted data which is stored on said memory (column 7, lines 48-53 and column 15, lines 3-26); the transceiver in response to said storing of the adaptation data transmits an acceptance signal (column 7, lines 38-44); and said acceptance signal is used by the server for computing remuneration data related to the adaptation data if successfully downloaded (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

- <Claims 23 and 26>

A method for downloading adaptation data from a server to a portable radio communication device, comprising: allowing at least selective access to the adaptation data on a memory of the server for download to the portable radio communication device

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(column 5, lines 17-37 and column 15, lines 3-26); downloading the adaptation data from the memory of the server to the portable radio communication device (column 15, lines 3-26); monitoring the downloading of adaptation data from the server (column 7, lines 38-44); applying the adaptation data to electronic content stored on the portable radio communication device so as to modify the electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the applying of the adaptation data to the electronic content (column 7, lines 38-46); and if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content, computing remuneration data related to the electronic content and the adaptation data based on the generated data (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

- <Claims 24 and 27>

A method according to claim 23, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- <Claim 25>

A method according to claim 23, further comprising, before downloading the adaptation data, determining whether the portable radio communication device is entitled to access to the adaptation data, and wherein the adaptation is downloaded to the portable radio communication device only if the portable radio communication device is entitled to access the adaptation data (column 7, lines 46-53).

- <Claim 28>

A method according to claim 16, further comprising providing payment, by the content enabler, to the content provider based on said remuneration data, wherein said remuneration data corresponds to one or more downloads of said adaptation data from said server by one or more end-users (column 7, lines 38-53 and Srinivasan, column 7, lines 55-60).

- <Claim 29>

A system according to claim 19, wherein said remuneration data corresponds to one or more downloads of said adaptation data from said memory of said server by one or more end-users and wherein the content enabler comprises the determination means which records the one or more downloads of said adaptation data from said server by the one or more end-users and provides payment to the content provider based on said remuneration data (column 7, lines 38-53 and Srinivasan, column 7, lines 55-60).

- <Claim 30>

A portable radio communication device according to claim 21, wherein the acceptance signal contains an indication that the adaptation data has been successfully applied to the electronic content (Srinivasan, column 6, lines 27-36).

- <Claim 31>

A portable radio communication device according to claim 21, wherein the server computes the remuneration data based on one or more downloads of the adaptation data to the portable radio communication device and the server provides payment to a

provider of the electronic content based on the remuneration data (column 7, lines 38-53 and Srinivasan, column 7, lines 55-60).

- <Claim 32>

A server according to claim 22, wherein the computing means computes remuneration data only if the generated data comprises an indication that the adaptation data has been successfully applied to the electronic content (Srinivasan, column 6, lines 27-36).

- <Claim 33>

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising: providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48); providing adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26); downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26); applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and computing remuneration data including monitoring the volume of downloads that the server is performing and computing the payment to be made to a content provider on the basis of the level of successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

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- <Claim 34>

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising: providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48); providing adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26); downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26); applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); receiving a signal that the download of adaptation data has been successfully received; and registering receipt of said signal in a counter (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36).

Since the combination of Peng and Srinivasan discloses all of the above limitations, claims 15-34 are rejected.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

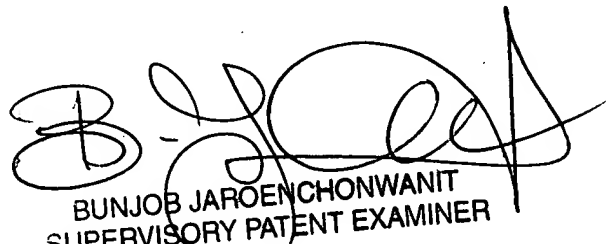
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Patent Examiner
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SUPERVISORY PATENT EXAMINER
5/7/7